

### REMARKS/ARGUMENTS

Claims 8 and 9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1 to 11 and 21 to 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sarring, U.S. Patent No. 3,722,336, in view of Kile et al., U.S. Patent No. 3,122,041.

#### Claim

Reconsideration of the application in view of the following remarks is respectfully requested.

#### Examiner Interview Summary

Applicants' representative, Clint Mehall, Reg. No. 62,380, spoke with Examiner Nguyen on August 25, 2010 to discuss the rejection of claim 8 under 35 U.S.C. 112, Second Paragraph. Mr. Mehall explained to Examiner Nguyen that all of the figures in the present application are directed to a single embodiment of the present invention including a transfer belt assembly 30 (i.e., transfer element), which includes continuous upper belt 254 and continuous lower belt 256 (see, e.g., Fig. 9), and a side table 44. Mr. Mehall also explained that, for clarity, table 44 is not shown in Fig. 9 and continuous lower belt 256 is not shown in Figs. 14 to 18; however, the description at paragraphs [0095] to [0111] and [0115] clearly illustrates belts 254, 256 positively grip a book 54 as book 54 is clamped, cut and unclamped side table 44. Examiner Nguyen acknowledged this disclosure and indicated that the rejection of claim 8 under 35 U.S.C. 112, Second Paragraph, was improper. Additionally, Mr. Mehall explained to Examiner Nguyen that at the time of the present invention nothing in the prior art taught gripping a sheet material article with a transfer element as the sheet material article is carried on a side table and being side trimmed. The prior art only taught gripping a sheet material article with the side table and not with a transfer element that carries the sheet material article to the side table. Applicants' representatives sincerely thank Examiner Nguyen for his courtesy during the interview.

#### 35 U.S.C. §112, Second Paragraph, Rejections

Claims 8 and 9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Office Action asserted that claim 8 was indefinite because the claimed apparatus uses a side

table 44 or a lower belt 256 to transfer a book from a front trimming station to a side trimming station. As discussed above in the Examiner Interview Summary, the description at paragraphs [0095] to [0111] and [0115] clearly illustrates belts 254, 256 positively grip a book 54 as book 54 is clamped, cut and unclamped side table 44. Thus, it is respectfully submitted that claim 8 is clear and definite.

The Office Action also asserted that claim 9 was indefinite because “it appears that the side table is the shuttle mechanism but not the transfer belt.” Paragraph [0099] of the present application discloses that belts 254, 256 may be replaced by a shuttle mechanism. Thus, it is respectfully submitted that claim 9 is clear and definite.

Based on the foregoing, withdrawal of the rejection under 35 U.S.C. 103(a) of claims 8 and 9 is respectfully requested.

#### 35 U.S.C. §103(a) Rejections

Claims 1 to 11 and 21 to 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sarring, U.S. Patent No. 3,722,336, in view of Kile et al., U.S. Patent No. 3,122,041.

Sarring shows feed, transport and delivery mechanisms for a two-station, three-knife book trimmer. (See col. 1; lines 5 to 7).

Kile et al. discloses a magazine trimmer including a base A, a reciprocating table B carried on the base, a crank supported trimming blade assembly C which reciprocates table B through roller guides which act as a scotch yoke, an infeed assembly F and a carrier assembly G. As seen in Fig. 4, a clamp mechanism D is carried directly upon table B, as is a stop mechanism E. (See Fig. 1 and col. 2, lines 39 to 46).

#### Independent Claim 1

Claim 1, as amended, recites “[a] transfer apparatus for a sheet material article trimmer, the transfer apparatus comprising:

a transfer element configured to grip the sheet material article and move the sheet material article in a transfer direction onto a moving side table of the sheet material article

trimmer, the moving side table carrying the sheet material article as the sheet material article is gripped by the transfer element; and

a driver configured to move the transfer element at a same speed as the moving side table during a first time period, the speed of the side table and the transfer element varying during the first time period, when the sheet material article is gripped by the transfer element and the side table is moving in the transfer direction.”

As discussed with Examiner Nguyen during the interview, the present invention involves a transfer apparatus that includes a transfer element that grips a sheet material article as the sheet material is carried on a side table. Claims 1 and 25 have been amended to clarify this point. The prior art only taught gripping a sheet material article with the side table and not with a transfer element that moves the sheet material article to the side table and grips the sheet material article as the sheet material article is carried by the side table. As the sheet material article is gripped by the transfer element, the speed of the transfer element is matched to the speed of the side table. Nothing in the prior art, including both Sarring and Kile, teaches gripping a sheet material article with a transfer element as the sheet material article is carried on a side table. The prior art only taught gripping a sheet material article with a single element during side trimming and one of skill in the art would not have had any reason to have gripped a sheet material article with a transfer element and a side table.

The Examiner alleges that upper belts 1008, 1009, 1010 of Sarring correspond to the “transfer element” recited in claim 1, but acknowledges that upper belts 1008, 1009, 1010 do not “move the sheet material article in a transfer direction onto a moving side table” as recited in claim 1. The Examiner then appears to assert that upper belts 1008, 1009, 1010 place books on lower belts 1290, 1292, 1294 and that it would have been obvious to one of skill in the art to have replaced lower belts, 1290, 1292, 1294 with a reciprocating table B of Kile to meet the limitations of claim 1.

It is respectfully submitted that even if lower belts 1290, 1292, 1294 of Sarring were replaced with reciprocating table B of Kile, the asserted combination would not “grip the sheet material article and move the sheet material article in a transfer direction onto a moving side table” as recited in claim 1. Belts 1008, 1009, 1010 of Sarring merely contact a top surface of the

books and are clearly not alone configured to “grip” the books. In order to grip the books, belts 1008, 1009, 1010 need to be used with lower belts 1290, 1292, 1294, which in the Examiner’s alleged combination, are removed and replaced by reciprocating table B of Kile, which the Examiner asserts corresponds to the “side table” of claim 1. Even if belts 1008, 1009, 1010 of Sarring and reciprocating table B of Kile could be considered together to be a transfer element configured to grip a sheet material article, belts 1008, 1009, 1010 of Sarring and reciprocating table B of Kile clearly do not “move the sheet material article in a transfer direction onto a moving side table” that “carr[ies] the sheet material article as the sheet material article is gripped by the transfer element” as recited in claim 1. The plain language of claim 1 clear requires that the “transfer element” in claim 1 is distinct from the “side table” in claim 1. Additionally, such a modification would not have been obvious to one of ordinary skill at the time of the present invention.

Based on the foregoing, withdrawal of the rejection under 35 U.S.C. 103(a) of claims 1 to 8, 10 and 21 to 24 is respectfully requested.

#### Independent Claim 25

Independent claim 25, as amended, recites “[a] transfer apparatus for a sheet material article trimmer, the transfer apparatus comprising:

a transfer element configured to grip the sheet material article and move the sheet material article in a transfer direction onto a side table of the sheet material article trimmer, the side table carrying the sheet material article as the sheet material article is gripped by the transfer element; and

a driver configured to move the transfer element at a same speed as the side table during a first time period when the sheet material article is gripped by the transfer element and the side table is moving in the transfer direction;

the driver including an epicycle gear unit, the epicycle gear unit including a constant speed input member driven by a main trimmer drive of the sheet material article trimmer and a variable speed input member configured for varying an output of the epicycle gear unit so as to vary a speed of the transfer element.”

As similarly discussed above, it is respectfully submitted that even if belts 1008, 1009, 1010 of Sarring and reciprocating table B of Kile could be considered together to be a transfer element configured to grip a sheet material article, belts 1008, 1009, 1010 of Sarring and reciprocating table B of Kile clearly do not “move the sheet material article in a transfer direction onto a side table” that “carr[ies] the sheet material article as the sheet material article is gripped by the transfer element” as recited in claim 25 and such a modification would not have been obvious to one of ordinary skill at the time of the present invention.

Based on the foregoing, withdrawal of the rejection under 35 U.S.C. 103(a) of claim 25 is respectfully requested.

**CONCLUSION**

It is respectfully submitted that the present application is now in condition for allowance, and Applicants respectfully request such action.

Respectfully submitted,

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